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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/981,312	10/15/2001	Mitchell A. Avery	1786	4970

29003 7590 09/24/2003
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EXAMINER
SMALL, ANDREA D SOUZA

ART UNIT PAPER NUMBER
1626

DATE MAILED: 09/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/981,312	AVERY, MITCHELL A.	
	Examiner	Art Unit	
	Andrea D Small	1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34, 69-72 and 74-78 is/are pending in the application.
- 4a) Of the above claim(s) 75-78 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-34 and 69-72 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

I. Preliminary Matters:

(a) Applicants response of 04/15/2003 has been received and entered into the file.

-Claims 35-68 and 73 have been cancelled as being drawn to non-elected inventions. 37

CFR 1.142(b)

-Claims 75-78 have been newly added.

(b) Applicants restatement of the interview and reform of the restriction requirement is accurate and is also represented below:

Group I	claims 1-34; 69-73;
Group II	claims 35-47 (the Examiner indicated that claims 44-47 may get restricted out);
Group III	claims 48-56;
Group IV	claims 57-58;
Group V	claim 59-61; and

Group VI claims 62-68.

Group VII claims 75-78, drawn to compounds of claim 75.

Applicants election of group I, claims 1-34 and 69-73 is acknowledged. The newly added claims 75-78 are withdrawn from consideration as being drawn to independent and distinct inventions from the elected group I and therefore stand withdrawn under 35 CFR 1.142(b).

Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Currently pending are claims 1-34, 69-72 and 74-78.

II. Supplemental Election:

The above grouped inventions themselves are inclusive of patentably distinct subject matter, which must be further restricted because patentably distinct species may be included together in a generic claim where the number of species is *reasonable* and where there is *no* serious burden on the examiner to examine all the grouped distinct species in one application. Accordingly, along with the election of one of the above groups, the following action is also taken.

It is to be noted that the following action is a restriction requirement placed on the instant claims; they are NOT being rejected as being an improper Markush claim. The entire contents of the claims will eventually be examined, either as elected subject matter in the instant application or as elected subject matter in divisional applications.

This application contains claims directed to the following patentably distinct species of the claimed invention, generic claim 1, which encompasses various moieties for W, which have acquired a separate status in the art. The ester function on the ring, places the classification for the moiety in class 558, the thiazole moiety places the classification in class 548, the ether functionality places the classification in 568, etc. Each of these species differs one from the other in structure, element, molecular formula, process of preparing, chemical interaction, etc., resulting in each of these species having acquired a separate status in the art. Examining this plurality of distinct species in the same application would result in a serious burden during examination. The search required, both electronic and manual database, for each of the patentably distinct species is separate and involves separate search considerations and search

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strategies. These searches are not co-extensive and the evaluation of the search results are divergent, so much so that searching for a reference that would anticipate a reasonably grouped invention, say for example, the ester species, would not even render the non-elected invention, say for example the thiazole species, obvious. Therefore, a serious burden would be placed on the office if restriction within these generic claims were not required.

A precise listing of all the possible sub-groups of inventions that would fall under any of the above main invention groups, identified in paragraph 2, cannot be made due to the sheer volume of species encompassed by the instant claims. Consequently, Applicant is required under 35 U.S.C. 121 to elect a single disclosed species or single preferred embodiment of their invention, even though this requirement is traversed. Additionally, whatever specific compound is ultimately elected, applicants are required to list all claims readable thereon.

Upon the election of a single disclosed species (e.g. Example, page number and structural depiction) or a preferred embodiment of the invention, a sub-group, inclusive of the elected species, will be identified by the Examiner for examination. This sub-group will establish the elected group to be examined and the remaining subject matter not within the confines of the sub-group will be withdrawn as non-elected subject matter. This remaining non-elected subject matter may then be pursued in divisional applications as is Applicants right under 37 CFR 1.142(b).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the

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examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement is traversed (37 CFR 1.143).

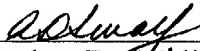
Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i)

III. Contact Information:

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrea D. Small whose telephone number is (703) 305-0811.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.

A facsimile center has been established. The hours of operation are Monday through Friday, 8:30-6:30 PM. The number for accessing the facsimile machine is (703) 746-4984.



Andrea D. Small, Esq.
Patent Examiner
Art Unit 1626, Group 1620
Technology Center 1600

September 22, 2003